

## REMARKS

### Summary

Claims 1-15, 20-22, and 32-49 were pending in this application. Claims 38-39 and 44-45 have been cancelled. No new matter has been added as a result of this amendment.

### 35 U.S.C. §112, first paragraph, Rejection of Claims

Claims 38-39 and 44-45 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. Applicants have cancelled Claims 38-39 and 44-45. Thus, the rejection is now moot.

### 35 U.S.C. §102(b)/103(a) Rejection of Claims

Claims 1-5, 8-12, 15, 20-22, 32-40 and 47-49 were rejected under 35 U.S.C. §103(a) as being obvious over Wheeler et al. (U.S. Patent 5,758,003; “Wheeler”) in view of Douglas et al. (U.S. Patent 6,819,857; “Douglas”). Claims 6-7, 13-14 and 44-46 were rejected under 35 U.S.C. §103(a) as being obvious over Wheeler in view of Douglas and further in view of Larsen et al. (U.S. Patent 6,365,834; “Larsen”). Claims 41-43 were rejected under 35 U.S.C. §103(a) as being obvious over Wheeler in view of Douglas and further in view of Solheid et al. (U.S. Patent 6,532,332; “Solheid”). Applicants traverse the rejections.

Claims 1 and 20 recite a rack that comprises, *inter alia*, a pass-through tray. The pass-through tray is configured such that cables are able to be routed between the front and rear sides of the rack. The pass-through tray includes at least one upstanding spool disposed substantially at a center of the tray. Similarly, Claim 9 recites a pass-through tray that comprises, *inter alia*, at least one upstanding spool disposed substantially at a center of the base of the tray. None of the cited references, alone or in combination, anticipate or suggest such an arrangement.

Neither Wheeler nor Douglas, alone or in combination, discloses a pass-through tray having a spool. Nor do Wheeler or Douglas, alone or in combination, specifically disclose a pass-through tray that comprises a spool disposed substantially at a center of the base of the tray.

Wheeler discloses spools 24 on the front surface of a frame 12 to gather excess cable slack. Wheeler also discloses a trough 18 on the back surface of the frame 12. The trough 18

and spools 24 are separated by a wall 20c. Wheeler does not disclose a pass-through tray having a spool.

Douglas discloses a storage tray 44 that includes a spool 98 used to store cable slack. The spool 98 is disposed substantially in the center of the storage tray 44. The storage tray 44 is vertically pivotably mounted on the outside of the vertical risers 26 and 28 of the rack (frame 22). However, the pass-through tray recited in Claims 1, 9 and 20 routes cables between the front side of the rack and the rear side of the rack. The storage tray 44 of Douglas, to the contrary, does not route cables between the front and rear of the rack. The storage tray 44 is vertically disposed on the outside of the frame 22. A cable 62 enters and exits the storage tray 44 in the same cable entry region 94. As shown in Fig. 12 of Douglas and explained in the corresponding text, the cable 62 is directed out of the storage tray 44, around a radius limiter 50 on the frame 22, and through a grommet 54 on the frame 22 to be connected with equipment mounted on the inside of the frame 22. Thus, the storage tray 44 of Douglas does not route cables from the front side of the rack and the rear side of the rack.

Accordingly, neither Wheeler nor Douglas alone specifically discloses a rack having a pass-through tray that contains a spool disposed substantially at a center of a base of the tray.

Further, combining the arrangements of Douglas and Wheeler does not produce the arrangement recited in Claims 1, 9 and 20. Instead, the combination of Douglas and Wheeler produces multiple spools for storing cable slack – one spool 24 adjacent to, but separated from, a trough 18 by a wall 20c (as in Wheeler), and another spool 98 on a storage tray 44 that is vertically attached to the outside of a vertical riser of the frame 12 (as in Douglas).

Moreover, there is no motivation to combine the particular elements of the arrangements of Douglas and Wheeler. In particular, no motivation exists to combine the spool 98 of the tray 44 of Douglas with the trough 18 of Wheeler. Merely finding the same materials being used in a variety of dissimilar situations does not constitute evidence of a motivation to combine. “Substantially all inventions are the combination of old elements; what counts is the selection out of all their possible permutations, of that new combination which will be serviceable.” *Safety Car Heating and Lighting Co. v. General Electric Co.*, 155 F.2d, 937, 939 (2d Cir, 1946). Moreover, even if the disparate elements in the various devices could be combined, MPEP 2143.01 states that the mere fact that references can be combined or modified does not render the

resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

In the instant case, neither Wheeler nor Douglas suggest any reason for storing excess cable on a pass-through tray. Wheeler explicitly teaches a separate spool for cable storage. Douglas teaches a storage tray rather than a trough, a different location for the storage tray than the trough of Wheeler, and entirely different features associated with the cable storage. For example, Douglas teaches a storage tray with a single entrance/exit. Thus, cables entering and exiting the storage tray must be directed around a separate radius limiter and through a grommet to be connected with equipment. Douglas also teaches a pivot system 75 that allows the storage tray 44 to be pivoted or rotated to the front of the rack so that it is easily accessible to the service operator. Thus, aside from placement issues of the storage tray 44 of Douglas and the trough 18 of Wheeler, there is no explanation as to why (or how) someone of skill in the art would specifically pluck only the storage spool from the vertical storage tray of Douglas and put it on the trough of Wheeler. Similarly, there is no explanation of how someone of skill in the art would incorporate the other features of the storage tray of Douglas (the separate radius limiter and pivot system) in the trough of Wheeler.

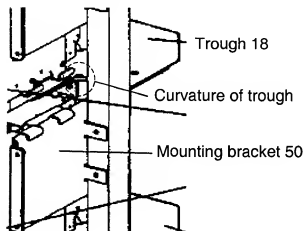
Note that even incorporating the pivot system of Douglas would not result in a cable slack management spool that was readily accessible to a service operator at the front of the rack, as the trough 18 of Wheeler is separated from the front of the rack by a wall 20c. Thus, the pivot system would be rendered inoperable. MPEP 2143.01 states that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In summary, there is no reason to incorporate only the cable slack spool of Douglas in the trough of Wheeler.

Accordingly, neither Wheeler nor Douglas, alone or in combination, anticipates or suggests an arrangement in which a spool is disposed proximate to a center of a pass-through tray, as recited in Claims 1 and 20, or proximate to the center of a base, as recited in Claim 9. Thus, for at least this reason, Claims 1, 9, and 20 are patentable over the cited references.

As Claims 1, 9, and 20 are patentable, Claims 2-8, 10-15, 20-22, 32-37, 40-43, and 46-49 are patentable, without more.

In rejecting pending Claims 35-37 and 40, the Office Action indicates that Fig. 1 of Wheeler shows a sidewall of the tray and flanges extending from the sidewall through which the tray is mounted to the frame. The Office Action specifically indicates that element 50 of Wheeler is the sidewall of the tray (trough 18). However, element 50 is not a sidewall of the tray, but is a mounting bracket 50 used to mount an assembly 30 to a support 16 (see, *e.g.*, Figs. 1, 6, and 11 and col. 4, lines 42 – 46). Moreover, the figures in Wheeler show that the mounting bracket 50 is not connected to the trough 18. This is shown more clearly in Applicants' Fig. 1E' below, which is a section of Fig. 1 of Wheeler with labeling added by Applicants.



Applicants' Fig. 1E'

The dashed circle in Fig. 1E' emphasizes that the trough 18 curves around, but does not contact, the mounting bracket 50.

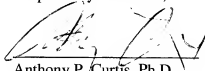
Thus, Wheeler does not disclose that the trough 18 has a sidewall, or that the trough 18 is mounted to the frame through flanges extending from the sidewall, as recited in the claims.

For at least these reasons, neither Wheeler nor Douglas anticipate or suggest the arrangements of pending Claims 35-37 and 40. Thus, pending Claims 35-37 and 40 are independently patentable over the cited references.

## **Conclusion**

Applicants submit that the pending claims are in condition for allowance. If the Examiner believes that a telephone interview would be desirable to clear up further issues, the Examiner is encouraged to contact the undersigned at the telephone number below. Applicants herein petition for any extension of time necessary for the submission of this response. The Commissioner is authorized to charge the one-month extension fee as well as any other fee deemed necessary for the submission of this response, except the issue fee, to deposit account number 16-0228.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

Anthony P. Curtis, Ph.D.  
Reg. No. 46,193  
Attorney for Applicants

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Customer Number 32915  
Panduit Corp.  
Legal Department - TP12  
17301 S. Ridgeland Avenue  
Tinley Park, Illinois 60477-3091  
(708) 532-1800, Ext. 1369